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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,977	03/02/2004	Jenn-Han Chen	UPS-014	4850
3897	7590	04/20/2007	EXAMINER	
SCHNECK & SCHNECK			LIU, SUE XU	
P.O. BOX 2-E			ART UNIT	
SAN JOSE, CA 95109-0005			PAPER NUMBER	
			1639	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/20/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,977	<b>Applicant(s)</b> CHEN ET AL.	
	<b>Examiner</b> Sue Liu	<b>Art Unit</b> 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Status***

1. Claims 3-5 and 7 have been canceled as filed on 2/1/07.

Claims 1, 2 and 6 are currently pending.

Claims 1, 2 and 6 are being examined in this application.

### ***Election/Restrictions***

2. Applicant's election of Group I, claims 1-6 over the phone, as acknowledged in the previous Office action, has been confirmed by applicants in the Reply, (filed on 2/1/07).

Applicants also elected "aldehyde slide" as a species of slides during the same telephone conversation on 7/14/06, as previously acknowledged.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. (Foreign priority paper: Taiwan 92115883; 6/11/03).

### ***Claim Objections and Rejections Withdrawn***

4. In light of applicant's cancellation of claim 5, the following claim objection as set forth in the previous office action is moot:

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Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

5. In light of applicants' amendments to the claims and supporting arguments (Reply, p. 3), the following claim rejections as set forth in the previous office action are withdrawn:

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim Rejections Maintained**

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ault-Riche et al (US 2002/0137053 A1; 9/26/2002), in view Martin et al (US 2003/0082633 A1; 5/1/2003; filed 9/5/2002), Schleifer et al (US 2003/0231989 A1; 12/18/2003; filed 6/14/2002), Jacob et al (US 2002/0095073; 7/18/2002), and Duhamel et al (Journal of Histochemistry and Cytochemistry. Vol. 33 (7): 711-714; 1985). The previous rejection is maintained for the reasons

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of record as set forth in the Office action, mailed 10/4/06, at p. 7+. The rejection over claims 3-5, is moot due to applicant's cancellation of the said claims.

Discussion and Answer to Argument

8. Applicant's arguments have been fully considered but they are not persuasive for the following reasons (in addition to reasons of record). Each point of applicant's traversal is addressed below (applicant's arguments are in italic):

*In general, applicants have traversed the above rejection by arguing over the Martin reference alone.*

The above rejection under 35 USC 103(a) is over a combination of references, and not over the Martin reference alone. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

*Applicants argue because the Martin reference teaches "microwave heating was applied to heat a bulk aqueous target," and using solid support including "a dielectric under a reactant surface", the reference "teaches away from the applicant's claimed method in which a glass slide is used without a dielectric layer to focus microwave energy". (Reply, p. 4, para 2).*

First, applicant's recited feature "a glass slide ... without a dielectric layer to focus microwave energy" is not a feature recited in the instant claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a glass slide without a dielectric layer) are not

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recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Contrary to applicant's assertion, the Martin reference teaches using "microwave heating directed to a solid surface". As discussed in the previous Office action (Reply 10/4/06, pp. 10+):

"The reference also teaches the preferred surface is glass slides (p. 11, [0149]), and microwave can be used to attach molecules such as proteins onto a surface (p. 10, 0139]), which reads on the immobilization (or attachment) of protein to the slides of **clm 1**."

Thus, the reference teaches using microwave to heat a surface for attaching chemical entities such as proteins, and the reference does not teach away from the instant invention

Applicants also seem to argue that because one of the "preferred embodiments" of the reference's teaching maybe different from the instant invention, the reference teaches away from the instant invention. Applicants are respectively directed to MPEP 2123:

"A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989)."

*Applicants also argue "the specific uses of microwave energy as claimed by Applicant are not disclosed." Specifically, the two steps of "immobilization of proteins" and "blocking" are not taught by the Martin reference.*

Again, applicants' argument only relied on one single reference (Martin) out of the combination of references used for the above said rejection. As discussed in the previous Office

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action (mailed 10/4/06, pp. 7+; especially, p. 10), the combination of the references teaches all element of the instant invention including the “immobilization” and “blocking” steps.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Liu whose telephone number is 571-272-5539. The examiner can normally be reached on M-F 9am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Schultz can be reached at 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JON EPPERSON  
PRIMARY EXAMINER



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4/13/07